

Appln. No. 09/750,288
Amendment dated October 9, 2003
Reply to Office Action of July 15, 2003

REMARKS

The Office Action of July 15, 2003 has been reviewed and these remarks are responsive thereto. Claims 1, 2, 4, 7, 8, 9 14, 17 and 22 have been amended. New claims 29-30 have been added. Claims 1-30 are pending. Reconsideration and allowance of the instant application are respectfully requested.

Claims 1 and 3-6

The Office Action relies on U.S. Patent No. 6,335,727 to Morishita et al. (hereinafter referred to as Morishita) to reject claims 1-8, 14-21 and 27-28 under 35 U.S.C. § 102(e). It is respectfully asserted that Morishita fails to describe a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink based on a shape of said electronic ink; and associating the classified electronic ink with at least one object of the displayed information. The Office Action alleges that Morishita teaches classifying the electronic ink by equating it to "the classifying of first and second mode..." Office Action, ¶ 5. Morishita, however, **does not** classify electronic ink, but merely designates *a search region within electronic ink*. Further, Morishita does not classify electronic ink based on a shape of an ink stroke. Morishita only makes reference to the selection of a first and second mode in which a user may manually select one of two *selection modes* to specify a search region within a closed curve or a rectangular. Morishita states that FIGS. 44A to 44C "show an example for **searching** designated writing information from the information storing section 13." (Emphasis added)(Morishita, col. 25, lines 41-58).

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Claim 1 further recites among other features “associating said classified electronic ink with at least one object of said displayed information.” The Office Action asserts that Morishita teaches associating electronic ink with at least one object of the displayed information by “searching a written image in a region enclosed within a closed curve...” Office Action, ¶ 5. However, searching a written image in a region enclosed within a closed curve does not suggest or teach associating electronic ink with at least one object of the displayed information. In fact, Morishita does not suggest associating electronic ink with anything remotely similar to an object of the displayed information. Morishita merely describes a search curve with a selected region on a paper sheet. (See Morishita, col. 25, lines 41-48). Morishita fails to teach each and every feature of claim 1. Thus, claim 1 is allowable over Morishita for at least these reasons.

Claims 3-6 depend from claim 1 and are thus allowable for at least the same reasons as claim 1.

As to claim 3, Morishita fails to teach or suggest a classifying step that includes the step of “determining its distance to other annotations.” Morishita fails to describe annotations, much less teach or suggest determining a distance to an annotation. There is absolutely no teaching that the alleged width determination of a recorded writing pattern and displayed writing pattern of Morishita describes a recited feature of “determining its distance to other annotations.” (See Morishita, col. 24, lines 46-59). Thus, claim 3 is allowable for at least this reason.

Regarding claim 4, Morishita does not teach or suggest “determining the ratio of said electronic ink height to width.” There is absolutely no teaching that the alleged width

determination of a recorded writing pattern and displayed writing pattern of Morishita describes a classifying step which determines the ratio of the electronic ink height to width. Thus, claim 4 is allowable for at least this reason.

Claim 2

With regard to claim 2, the Office Action alleges that Morishita teaches classifying electronic ink as one of embedded ink and overlaid ink. Office Action, ¶ 5. Applicants note that claim 2 has been rewritten to an independent form to incorporate the original base claim 1. It is respectfully asserted that Morishita fails to teach or suggest a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink and associating the electronic ink with at least one object of the displayed information wherein the classifying step includes classifying electronic ink as one of **embedded ink and overlaid ink**.

As set forth in claim 2, the recited electronic ink is added to the displayed information and is classified as one of embedded ink and overlaid ink. In clear contrast, the alleged embedded ink described in Morishita refers to ink within the information writing section 11 of the so-called information input device 10. Morishita states that “[w]hen the surface of the position information holding device 25 is colored in white by special optical coating, and **a writing section using a special ink is embedded in the information writing section 11**, a writing operation can be performed using the position information holding device 25 itself as a writing medium 29 (display device) without using paper.” (emphasis added) (Morishita, col. 30,

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lines 64-67 to col. 31, lines 1-3). Thus, Morishita does not have the recited provision. Further, Morishita is **completely devoid** of a feature of classifying electronic ink as **overlaid ink**. Thus, Morishita fails to teach each and every feature of claim 2. Claim 2 is allowable for at least any one of the foregoing reasons.

Claim 7

With regard to claim 7, Morishita does not teach or suggest “anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink.” Applicants note that claim 7 has been rewritten to an independent form to incorporate the original base claim 1. It is respectfully asserted that Morishita fails to teach or suggest a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink and associating the electronic ink with at least one object of the displayed information wherein **said associating step further includes the step of: anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink.**

The Office Action asserts that the closed curve being near the search region is sufficiently similar to claim 7 to sustain the rejection under 35 U.S.C § 102(e). (See Office Action ¶ 5). Sufficiently similar is not the legal standard for anticipation. Each and every feature must be present in the reference, not merely appear to be similar. Applicant respectfully requests the Patent Office apply the correct legal standard to claim 7. Nevertheless, Applicants respectfully state that claim 7 is allowable and the rejection under 35 U.S.C. § 102(e) must be withdrawn.

Claim 8

Applicants note that claim 8 has been rewritten to an independent form to incorporate the original base claim 1. Claim 8 was rejected under 35 USC § 112, second paragraph. Among other features claim 8 recites, “the relationship of said electronic ink to said at least one object is maintained despite re-flowing of said displayed information by a layout engine.” The re-flow concept is supported at least on pages 26-28 and shown in FIGS. 14-16 of the instant application. For example, in one embodiment, as shown in Figure 14 of page 1401, ink 1403 anchored to a single position in an in-line flow, and not in a margin, re-positions and re-scales along with the element immediately preceding or following the anchor. With respect to Figure 14, the outline 1403 on page 1401 continues to outline the text ‘in-line’ as 1404 in page 1402 despite the re-flow of text between the two pages, due to at least in part on the change in font size. Thus, the displayed information is re-flowed and the relationship of said electronic ink to said least one object is maintained. Applicants respectfully request withdrawal of the rejection.

The Office Action alleges that Morishita shows that electronic ink may be maintained despite having other information. It is respectfully asserted that Morishita is completely devoid of a concept re-flowing displayed information including an object and maintaining the relationship of the added electronic ink with the object. Morishita fails to teach each and every feature of claim 8 as recited. Thus, claim 8 is allowable over Morishita.

Claims 14-21

Independent claim 14 recites among other features “[a] computer readable medium having a program stored thereon,...said program comprising the steps of: classifying said electronic ink based on a shape of the electronic ink; associating said classified electronic ink with at least one object of said displayed information.” It is respectfully submitted that Morishita does not teach or suggest a program comprising the steps of classifying electronic ink based on a shape of the electronic ink and associating the classified electronic ink with at least one object of said displayed information. Thus, claim 14 is allowable for at least the same reasons as claim 1. Claims 15-21 depend from claim 14 and therefore are allowable for the same reasons.

Claim 15 is allowable for at least the same reasons as claim 2 with regard to Morishita **lack of teaching of the classifying step including classifying electronic ink as one of embedded ink and overlaid ink.**

Claims 16 and 17 are allowable for at least the same reasons as claims 3 and 4, respectively.

Claims 18 and 19 are allowable for at least the same reasons as claim 5 and 6, respectively.

Claim 20 is allowable for at least the same reasons as claim 7 with regard to Morishita **lack of teaching of said associating step further includes the step of: anchoring said electronic ink to said at least one object by adding a link at or near said object pointing to said electronic ink.**

Claim 21 is allowable for at least the same reasons as claim 8 with regard to Morishita **lack** of teaching of the relationship of said electronic ink to said at least one object is maintained despite re-flowing of said displayed information by a layout engine.

Claims 27 and 28

The Office Action relies on Morishita to reject claims 27 and 28 under 35 U.S.C. § 102(e). Applicants respectfully disagree with these rejections. Independent claim 27 recites, among other features, “wherein said processor classifies electronic ink related to signals received from said input, said processor associates said electronic ink to said content, said processor transforms said electronic ink, and said processor outputs said transformed electronic ink to said output.” Morishita does not teach or suggest a processor that **1) classifies electronic ink and associates electronic ink with the content; 2) transforms the electronic ink; and 3) outputs the transformed electronic ink**. Contrary to the Office Action, claim 27 recites different features than original claim 1. Nevertheless, Morishita fails to teach each and every feature of claim 27. Hence, claim 27 is allowable. Claim 28 depends from claim 27 and is thus allowable for at least the same reasons.

In addition, claim 28 recites that “said processor classifies said electronic ink based as one of embedded ink and overlaid ink.” Morishita does not teach or suggest classifying electronic ink as one of embedded ink and overlaid ink as discussed above with regard to claim 2. Morishita fails to teach each and every feature of claim 28. Hence, claim 28 is allowable.

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Claims 9-13 and 22-26

The Office Action proposes a combination of Morishita and US Patent No. 5,889,523 to Wilcox et al. to reject claims 9-13 and 22-26 under 35 U.S.C § 103(a). When evaluating patentability under 35 U.S.C. § 103(a), all claim features must be considered, especially when they are missing from the prior art. *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988) (Federal Circuit held a reference did not render the claimed combination obvious because the examiner ignored a claimed feature that was absent from the reference). With respect to claims 9-13 and 22-26, it is respectfully asserted that Morishita fails to describe a method for adding electronic ink to displayed information on a system having a display with an implementation of classifying the electronic ink based on a shape of said electronic ink and associating the classified electronic ink with at least one object of the displayed information. Thus, claims 9-13 and 22-26 are allowable for at least the reasons of claim 1. Further, Wilcox fails to teach the noted claimed features.

With regard to claims 9 and 22, the concept of in-line words is at least discussed on page 24 and shown in FIG. 13 of the instant application. For example as shown FIG. 13, the words 'This ink's in-line with text' 1305 were inserted into the flow of the text. Wilcox fails to teach "said classifying step classifies said ink as in-line words in which said at least one object is within a flow of text." The present invention as recited in claim 9 would be not disclosed, even if Morishita and Wilcox were combined.

With regard to claims 10 and 23, the concept of text marks is at least discussed on pages 24 and 25 of the instant application. Wilcox fails to teach "said classifying step classifies said ink

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as text marks.” The present invention as recited in claim 10 would be not disclosed, even if Morishita and Wilcox were combined.

New Claims 29-30

Claim 29 is presented to define further features of the present invention. Claim 29 depends from claim 2 and recites “wherein said embedded ink occupies an in-line flow of said at least one object.” It is respectfully asserted that claim 29 is allowable for being dependent on claim 2. Nevertheless, claim 29 is allowable because the references do not teach or suggest the inventive features as recited.

Claim 30 is presented to define further features of the present invention. Claim 30 depends from claim 1 and recites “wherein said step of classifying including classifying said electronic ink as a chain of strokes and said associating step includes associating a center of said chain of strokes with said at least one object.” It is respectfully asserted that claim 30 is allowable for being dependent on claim 1. Nevertheless, claim 30 is allowable because the references do not teach or suggest the inventive features as recited.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that this application is in condition for allowance. Should the Examiner believe that anything further is desirable in order to place the application in better form for allowance, the Examiner is respectfully urged to contact Applicants’ undersigned representative at the below-listed number. If any additional fees are

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required or if an overpayment has been made the Commissioner is authorized to charge or credit
Deposit Account No. 19-0733.

Respectfully submitted,

Date: October 9, 2003

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